

REMARKS

This Amendment is submitted in response to the Office Action dated January 28, 2002. In the Office Action, the Patent Office rejected Claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Martin et al.* (U.S. Patent No. 1,134,691). In addition, the Patent Office rejected Claims 1-4, 6-9, 14, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* (U.S. Des. Pat. No. 286,650) in view of *Martin et al.* The Patent Office also rejected Claims 5, 11 and 18 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* (U.S. Des. Pat. No. 286,650) in view of *Martin et al.* and further in view of Applicant's disclosure.

By the present Amendment, Applicant amended Claims 1, 9, 15 and 17. Applicant submits that the amendments to the claims overcome the rejections thereto as made by the Patent Office and places the application in condition for allowance.

In the Office Action, the Patent Office rejected Claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Martin et al.* This rejection is respectfully traversed in view of the claims as amended and for the reasons that follow.

Martin et al., the Patent Office alleges, discloses a marking device accessory kit having a marking device with a body defined between first and second ends and a tip capable of producing a mark on the first end. *Martin et al.* also allegedly provides an end cap removably attached on the second end of the marking device wherein the end cap is interchangeable between a plurality of marking devices. A chain extends from the end cap.

However, amended independent Claim 15 defines a marking device accessory kit. The accessory kit has a marking device having a body

defined between a first end and a second end wherein the first end has a tip capable of producing a mark. The marking device accessory kit further has a sheath that substantially covers the body of the barrel between the first end and the second end. The marking device accessory kit also has an end cap removably attached on the second end of the marking device. Further, the end cap is interchangeable between a plurality of marking devices. In addition, the marking device accessory kit has a connecting lead having a first end and a second end wherein the first end of the connecting lead extends from the end cap and is removably connected to the end cap.

Martin et al. merely disclose a marking device having an end cap attached to a flexible stem by a chain. *Martin et al.* do not disclose a sheath that substantially covers the body of the barrel between the first end and the second end. Moreover, no teaching or suggestion exists in *Martin et al.* for a sheath which substantially covers a marking device.

~~In view of the foregoing, the rejection of Claims 15 and 16 under 35 U.S.C. §103(a) is, therefore, improper and should be withdrawn. Notice to that effect is requested.~~

The Patent Office rejects Claims 1-4, 6-9, 14, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* The Patent Office also rejects Claims 5, 11 and 18 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* and further in view of Applicant's disclosure. Applicant submits that the rejections are improper for the reasons that follow.

Fischer is a design patent which discloses a sleeve for a writing instrument. The sleeve does not have an anti-bacterial substance thereon; however, the Patent Office alleges that page 7, line 17 of

Applicant's disclosure states that anti-bacterial substances are commonly used to coat a surface to render the surface sanitary. The Patent Office alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the sleeve in *Fischer* with an anti-bacterial coating.

In contrast, independent Claims 1, 9, 15 and 17, as amended, disclose a marking device having a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark. A sheath, or flat article, is provided that substantially covers the body of the barrel between the first end and the second end. Also provided is an end cap removably attached on the second end of the barrel wherein the end cap has a connecting lead extending from the end cap.

Fischer does not disclose a marking device having an end cap. Moreover, no teaching or suggestion exists in *Fischer* for a marking device having an end cap. *Martin et al.*, as stated above, do not disclose a sheath which substantially covers the barrel of the marking device wherein the sheath is separate from the end cap. As also stated previously, no teaching or suggestion exists in *Martin et al.* for a sheath which substantially covers a marking device. Accordingly, Applicant asserts that no motivation exists to combine the teachings of *Martin et al.* or *Fischer* to produce Applicant's invention.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the

art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's marking device, method for using the same and accessory kit. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Martin et al.* and *Fischer* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Martin et al.* and/or *Fischer* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

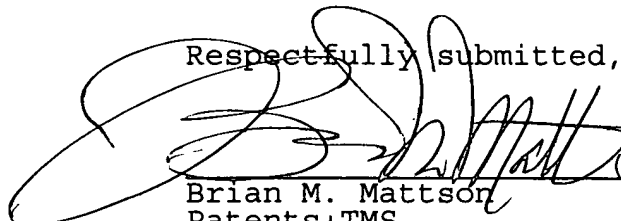
The Patent Office alleges, on pages 4 and 5 of the Office Action, that after reviewing both references, one skilled in the art would recognize that the *Fischer* marking device can be supported by the chain in *Martin et al.* Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's apparatus to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible. Applicant submits that for the reasons provided above, the rejections of Claims

1-9, 11, 14 and 17-19 by the Patent Office under 35 U.S.C. §103(a) are overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; Claims 10-13 depend from Claim 9; Claim 16 depends from Claim 15; and Claims 18-20 depend from Claim 17. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional novel elements of Applicant's novel marking device, accessory kit and method for using the same.

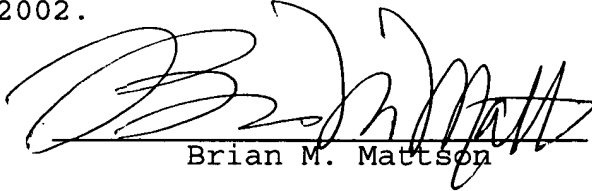
In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

 (Reg. No. 35,018)
Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647
773/772-6009
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Asst. Commissioner for Patents, Washington, D.C. 20231 on June 27 2002.


Brian M. Mattson



VERSION WITH MARKINGS TO SHOW CHANGES MADE

THE CLAIMS:

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Claim 1, as amended, follows:

1. (Amended) A marking device comprising:

a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

a sheath that [fits over] substantially covers the body of the barrel between the first end and the second end; and

an end cap removably attached on the second end of the barrel wherein the end cap has a connecting lead extending from the end cap.

Claim 9, as amended, follows:

9. (Amended) A marking device accessory kit, the accessory kit comprising:

a marking device having a barrel defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

a flat article wherein the article [wraps around] substantially covers the barrel of the marking device between the first end and the second end;

a clamp wherein the clamp removably secures the flat article around the barrel of the marking device; and

a cap having a lead extending from the cap wherein the cap is removably attached to the barrel at the second end.

Claim 15, as amended, follows:

15. (Amended) A marking device accessory kit, the accessory kit comprising:

a marking device having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

a sheath that substantially covers the body of the barrel between the first end and the second end;

an end cap removably attached on the second end of the marking device wherein the end cap is interchangeable between a plurality of marking devices; and

a connecting lead having a first end and a second end wherein the first end of the connecting lead extends from the end cap and is removably connected to the end cap.

Claim 17, as amended, follows:

17. (Amended) A method of using a marking device, the method comprising the steps of:

providing a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;

providing a sheath that [fits over] substantially covers the barrel between the first end and the second end;

providing an end cap for fitting over the second end of the barrel wherein the end cap has a connecting lead that extends from the end cap;

fitting the sheath over the barrel between the first end and the second end; and

fitting the end cap over the second end of the barrel.